

**713.07 Exposure of Other Cases**

Prior to an interview in the examiner's room, the examiner should arrange his or her desk so that all files, drawings and other papers, except those necessary in the interview, are placed out of view. See MPEP § 101.

**713.08 Demonstration, Exhibits, Models [R-2]**

The invention in question may be exhibited or demonstrated during the interview by a model thereof. A model received by the examiner from the applicant or his or her attorney which complies with 37 CFR 1.91 and which is made part of the application record must be properly recorded on the "Contents" portion of the application file wrapper. See MPEP § 608.03 and § 608.03(a). >For Image File Wrapper (IFW) processing, see IFW Manual section 3.6.<

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the \*>Technology Center< by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. If the model or exhibit is merely used for demonstration purpose and is not made part of the record (does not comply with 37 CFR 1.91), a full description as to what was demonstrated/exhibited must be made of record in the application. See 37 CFR 1.133(b). Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the examiner outside of the Office (in the Washington, D.C. area) with the approval of the supervisory patent examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

**713.09 Finally Rejected Application**

Normally, one interview after final rejection is permitted. However, prior to the interview, the intended purpose and content of the interview should be presented briefly, preferably in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more

than nominal reconsideration or new search should be denied. See MPEP § 714.13.

Interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without an extension of time. See MPEP § 706.07(f).

A second or further interview after a final rejection may be held if the examiner is convinced that it will expedite the issues for appeal or disposal of the application.

**713.10 Interview Preceding Filing Amendment Under 37 CFR 1.312**

After an application is sent to issue, it is technically no longer under the jurisdiction of the primary examiner. 37 CFR 1.312. An interview with an examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under 37 CFR 1.312 cannot be demanded as a matter of right.

Requests for interviews on cases where a notice of allowance has been mailed should be granted only with specific approval of the Technology Center Director upon a showing in writing of extraordinary circumstances.

**714 Amendments, Applicant's Action [R-2]**

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37 CFR 1.121. *Manner of making amendments in application.*

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

Enclosure (1)

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section.* A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document.* Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the

status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

(d) *Drawings.* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the header, labeled "Replacement Sheet." Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. All changes to the drawing(s) shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) *Amendments in provisional applications.* Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provi-

sional application shall be placed in the provisional application file but may not be entered.<

## I. WHEN APPLICANT MAY AMEND

The applicant may amend:

(A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112;

(B) after final rejection, if the amendment meets the criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of 37 CFR 1.121. Any amendments to a provisional application will be placed in the provisional application file, but may not be entered.

## II. MANNER OF MAKING AMENDMENTS

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All amendments filed on or after July 30, 2003 must comply with 37 CFR 1.121 as revised in the notice of final rule making published in the *Federal Register* on June 30, 2003 at 65 *Fed. Reg.* 38611. The manner of making amendments has been revised to assist in the implementation of beginning-to-end electronic image processing of patent applications. Specifically, changes have been made to facilitate electronic image data capture and processing and streamline the patent application process. If an amendment filed on or after July 30, 2003 does not comply with revised 37 CFR 1.121, the Office will notify applicants via a Notice of Non-Compliant Amendment that the amendment is not accepted. See MPEP § 714.03.

The revised amendment practice is summarized as follows.

### A. Amendment Sections

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet to facilitate separate indexing and electronic scanning of each section of an amendment document for placement in an image file wrapper.

It is recommended that applicants use the following format when submitting amendment papers. The amendment papers should include, in the following order:

(A) a cover sheet, or introductory comments, providing the appropriate application information (e.g., application number, applicant, filing date) and which serves as a table of contents to the amendment document by indicating on what page of the amendment document each of the following sections begin;

(B) a section (must begin on a separate sheet) entitled "Amendments to the Specification" (if there are any amendments to the specification). This section should include all amendments to the specification including amendments to the abstract of the disclosure;

(C) a section (must begin on a separate sheet) entitled "Amendments to the Claims" which includes a complete listing of all claims ever presented in the application (if there are any amendments to the claims);

(D) a section (must begin on a separate sheet) entitled "Amendments to the Drawings" in which all changes to the drawings are discussed (if there are any amendments to the drawings);

(E) a remarks section (must begin on a separate sheet); and

(F) any drawings being submitted including any "Replacement Sheet," "New Sheet," or "Annotated Marked-Up Drawings."

## **B. < Amendments to the Specification**

>Amendments to the specification, other than the claims, computer listings (37 CFR 1.96) and sequence listings (37 CFR 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification.< In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by \*\*>any replacement or new paragraph(s). Replacement paragraphs must include markings to show the changes. A separate clean version of any replacement paragraphs is not required. Any new paragraphs must be presented in clean form without any markings (i.e., underlining)<.

Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged.

37 CFR 1.121(b)(1)(ii) requires that the \*\*>full text of any replacement paragraph be provided with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters (e.g., [[eroor]]). The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived (e.g., deletion of the number "4" must be shown as [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4~~ as number 14 as). For added paragraphs, 37 CFR 1.121(b)(2)(iii) requires that the full text of any added paragraph(s) be presented in clean form without any underlining. Similarly, under 37 CFR 1.121(b)(2)(iv), a marked up version does not have to be supplied for any deleted paragraph(s). It is sufficient to merely indicate or identify any paragraph that has been deleted. The instruction to delete may identify a paragraph by its paragraph number, page and line number, or include a few words from the beginning, and end, or the paragraph, if needed for paragraph identification<.

Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided **\*\*>**with markings to show all the changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived<.

Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) >and (c)< are met. An accompanying separate marked up version showing the changes in the specification relative to the previous version is also required.

Any **\*\*>**previously deleted paragraph or section< can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

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### C. < Amendments to the Claims

**\*\*>**Each amendment document that includes a change to an existing claim, including the deletion of an existing claim, or submission of a new claim, must include a complete listing of all claims in the application. After each claim number, the status of the claim must be indicated in a parenthetical expression, and the text of each claim under examination as well as all withdrawn claims (each with markings if any, to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

(A) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously presented), (canceled), (withdrawn), (new), or (not entered). The text of all pend-

ing claims under examination and withdrawn claims must be submitted each time any claim is amended. Canceled and not entered claims must be listed by only the claim number and status, without presenting the text of the claims.

(B) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by strike-through (for deleted matter) or underlining (for added matter) with 2 exceptions: (1) for deletion of five or fewer consecutive characters, double brackets may be used (e.g., [[error]]); (2) if strike-through cannot be easily perceived (e.g., deletion of number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4~~ as number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" or "withdrawn" will include markings.

(C) The text of pending claims not being currently amended, including withdrawn claims, must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

(D) A claim being canceled must be indicated as "canceled;" the text of the claim must not be presented. Providing an instruction to cancel is optional.

(E) Any claims added by amendment must be indicated as "new" and the text of the claim must not be underlined.

(F) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or not entered claims may be aggregated into one statement (e.g., Claims 1 - 5 (canceled)).

A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn): A process for molding a bucket.

Claim 7 (previously presented): A bucket with a handle.

Claim 8 (currently amended): A bucket with a green blue handle.

Claim 9 (withdrawn): The process for molding a bucket of claim 6 using molten plastic material.

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (previously presented): A bucket having a circumferential upper lip.

Claim 13 (not entered)

Claim 14 (new): A bucket with plastic sides and bottom.<

37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. >Examiner's amendments do not need to comply with paragraphs (b)(1), (b)(2), or (c) of 37 CFR 1.121.< See MPEP § 1302.04.

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#### D. < Amendments to the Drawing

\*\*>Any changes to an application drawing must comply with 37 CFR 1.84 and must be submitted on a replacement sheet of drawings. The replacement sheet of drawings must be an attachment to the amendment document and must be identified in the top margin as

"Replacement Sheet." The replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.<

An explanation of the changes made must be presented in >the "Amendments to the Drawings" or< the remarks section of the amendment >document<. If the changes to the drawing figure(s) are not approved by the examiner, applicant will be notified in the next Office action. \*\*

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### III. <AMENDMENT IN REEXAMINATION PROCEEDINGS >AND REISSUE APPLICATIONS<

>Amendments in reissue applications must be made in accordance with 37 CFR 1.173. Amendments in *ex parte* and *inter partes* reexamination proceedings must be made in accordance with 37 CFR 1.530.< In patent-owner-filed >*ex parte*< reexaminations, the patent owner may amend at the time of the request for >*ex parte*< reexamination in accordance with 37 CFR 1.510(e). In any >*ex parte*< reexamination proceeding, no amendment or response can be filed between the date of the request for >*ex parte*< reexamination and the order for >*ex parte*< reexamination. See 37 CFR 1.530(a). Following the order for >*ex parte*< reexamination under 37 CFR 1.525 and prior to the examination phase of \*>*ex parte*< reexamination proceeding, an amendment may be filed only with the patent owner's statement under 37 CFR 1.530(b). During the examination phase of the >*ex parte*< reexamination proceeding, an amendment may be filed:

(A) after the first examination as specified in 37 CFR 1.112:

(B) after final rejection or an appeal has been taken, if the amendment meets the criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

See also MPEP § 714.12.

For amendments in *>ex parte<* reexamination proceedings see MPEP § 2250 and § 2266. >For amendments by patent owner in an *inter partes* reexamination proceeding, see MPEP § 2666.01 and § 2672. For amendments in reissue applications, see MPEP § 1453.<

## 714.01 Signatures to Amendments

An amendment must be signed by a person having authority to prosecute the application. An unsigned or improperly signed amendment will not be entered. See MPEP § 714.01(a).

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature.

### 714.01(a) Unsigned or Improperly Signed Amendment [R-2]

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

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(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered attorney or agent of record appointed in compliance with § 1.34(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

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An unsigned amendment or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where

the amendment is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

If copies of papers which require an original signature as set forth in 37 CFR 1.4(e) are filed, the signature must be applied after the copies are made. MPEP § 714.07.

When an unsigned or improperly signed amendment is received the amendment will be listed *\*\*>*in the contents of the application file<, but not entered. The examiner will notify applicant of the status of the application, advising him or her to furnish a duplicate amendment properly signed or to ratify the amendment already filed. In an application not under final rejection, applicant should be given a 1-month time period in which to ratify the previously filed amendment (37 CFR 1.135(c)).

Applicants may be advised of unsigned amendments by use of form paragraph 7.84.01.

#### ¶ 7.84.01 Paper Is Unsigned

The proposed reply filed on [1] has not been entered because it is unsigned. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney or agent of record, since he or she may have the authority to sign the amendment.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of 37 CFR 10.11 is not entered. The file and unentered amendment are submitted to the Office of Enrollment and Discipline for appropriate action.

### 714.01(c) Signed by Attorney or Agent Not of Record

See MPEP § 405. A registered attorney or agent acting in a representative capacity under 37 CFR 1.34, may sign amendments even though he or she does not have a power of attorney in the application. See MPEP § 402.

### **714.01(d) Amendment Signed by Applicant but Not by Attorney or Agent of Record**

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney or agent, the amendment should be entered and acted upon. Attention should be called to 37 CFR 1.33(a) in patent applications and to 37 CFR 1.33(c) in reexamination proceedings. Two copies of the action should be prepared, one being sent to the attorney and the other directly to the applicant. The notation: "Copy to applicant" should appear on the original and on both copies.

### **714.01(e) Amendments Before First Office Action [R-2]**

A preliminary amendment is an amendment that is received in the Office on or before the mail date of the first Office action under 37 CFR 1.104. See 37 CFR 1.115(a). \*\*>Since a request for continued examination (RCE) is not a new application, an amendment filed before the first Office action after the filing of the RCE is not a preliminary amendment. See MPEP § 706.07(h).

#### **I. PRELIMINARY AMENDMENTS MUST COMPLY WITH 37 CFR 1.121**

Any preliminary amendment, regardless of when it is filed, must comply with 37 CFR 1.121, e.g., the preliminary amendment must include a complete listing of all of the claims and each section of the amendment must begin on a separate sheet of paper. See MPEP § 714. Preliminary amendments made in a transmittal letter of the application will not comply with 37 CFR 1.121. For example, applicants should include the reference to a prior filed application in the first sentence of the specification following the title or in an application data sheet in compliance with 37 CFR 1.78 instead of submitting the reference in a preliminary amendment in a transmittal letter. See MPEP § 201.11. If a preliminary amendment fails to comply with 37 CFR 1.121, applicant will be notified by way of a Notice of Non-Compliant Amendment and given a non-extendable period of one month to bring the amendment into compliance with 37 CFR 1.121. If the applicant takes no corrective action, examination

of the application will commence without consideration of the proposed changes in the non-compliant preliminary amendment. See MPEP § 714.03.

Filing a preliminary amendment is not recommended because the changes made by the preliminary amendment may not be reflected in the patent application publication even if the preliminary amendment is referred to in an oath or declaration. If there is insufficient time to have the preliminary amendment be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun, the preliminary amendment will not be reflected in the patent application publication. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. For more information on publication of applications, see MPEP § 1121. Applicants may avoid preliminary amendments by incorporating any desired amendments into the text of the specification including a new set of claims, even where the application is a continuation or divisional application of a previously filed patent application. In such a continuation or divisional application, a clean copy of a specification (i.e., reflecting amendments made in the parent application) may be submitted together with a copy of the oath or declaration from the previously filed application so long as no new matter is included in the specification. See 37 CFR 1.63(d)(1)(iii) and MPEP § 201.06(c).

#### **II. PRELIMINARY AMENDMENTS FILED WITH THE APPLICATION<**

A preliminary amendment not filed along with the original application does not enjoy the status of part of the original disclosure. See MPEP § 608.04(b). Where an application filed under 37 CFR 1.53(b) is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. The subsequently filed oath or declaration must refer to both the application and the amendment. >If the subsequently filed oath or declaration refers to the application but does not refer to the amendment, applicants will be required to submit a supplemental oath or declaration referring to both the application and the amendment filed with the original application.< Any copy of the application as filed must include a copy of the amendment as well, particularly



where certified copies for priority purposes are requested.

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Any amendment canceling claims in order to reduce the filing fee should be filed with the application. \*\* See MPEP § 506. >If a preliminary amendment accompanying a nonprovisional application cancels claims, it will be effective to diminish the number of claims to be considered in calculating the filing fee. See MPEP § 607. If the preliminary amendment accompanying the nonprovisional application cancels all claims without presenting any new claims, the Office will not enter such an amendment. See *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1369 (Fed. Cir. 2001) and MPEP § 601.01(e). Thus, the application will not be denied a filing date merely because such a preliminary amendment was submitted on filing. For fee calculation purposes, the Office will treat such an application as containing only a single claim.

### III. PRELIMINARY AMENDMENTS MUST BE TIMELY

Any preliminary amendments should either accompany the application or be filed after the application has received its application number and filing date so that the preliminary amendments would include the appropriate identifications (e.g., the application number and filing date). See MPEP § 502. Any amendments filed after the mail date of the first Office action is not a preliminary amendment. If the date of receipt (37 CFR 1.6) of the amendment is later than the mail date of the first Office action and is not responsive to the first Office action, the Office will not mail a new Office action, but simply advise the applicant that the amendment is nonresponsive to the first Office action and that a responsive reply must be timely filed to avoid abandonment. See MPEP § 714.03.<

A preliminary amendment will be entered unless it is disapproved by the \*>Director<. A preliminary amendment may be disapproved by the \*>Director< if the preliminary amendment unduly interferes with the preparation of an Office action. 37 CFR 1.115(b). See MPEP § 714.03(a).

## 714.02 Must Be Fully Responsive [R-2]

37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

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(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Director. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:<

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

In all cases where reply to a requirement is indicated as necessary \*>for< further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must

either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters, although the filing of drawing corrections in reply to an objection to the drawings cannot normally be held in abeyance. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of an application may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 37 CFR 1.121(c). The requirements of 37 CFR 1.111(b) must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held not fully responsive for that reason alone. (See 37 CFR 1.112, MPEP § 706.)

The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

An amendment which does not comply with the provisions of 37 CFR 1.121(b), (c), (d), and (h) may be held not fully responsive. See MPEP § 714.22.

Replies to requirements to restrict are treated under MPEP § 818.

### 714.03 Amendments Not Fully Responsive, Action To Be Taken [R-2]

37 CFR 1.135. Abandonment for failure to reply within time period.

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(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inad-

vertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

An examiner may treat an amendment not fully responsive to a non-final Office action by:

(A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135;

(B) notifying the applicant that the reply must be completed within the remaining period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)) to avoid abandonment; or

(C) setting a new time period for applicant to complete the reply pursuant to 37 CFR 1.135(c).

The treatment to be given to the amendment depends upon:

(A) whether the amendment is *bona fide*;

(B) whether there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action; and

(C) the nature of the deficiency.

If an amendment submitted on or after July 30, 2003, fails to comply with 37 CFR 1.121 (as revised on June 30, 2003), the Office will notify applicant by a Notice of Non-Compliant Amendment, that the amendment fails to comply with the requirements of 37 CFR 1.121 and applicant will be given a period of time in which to comply with the rule. Applicant's reply to a Notice of Non-Compliant Amendment should consist of a corrected version of only that portion of the amendment which previously failed to comply with 37 CFR 1.121. It is not necessary for applicant to resubmit the entire amendment document. If the amendment that fails to comply with the requirements of the rule is a preliminary amendment, the Legal Instruments Examiner (LIE) will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply. No extensions of time are permitted. Failure to submit a timely reply will result in the application being examined without entry of the preliminary amendment. If the amendment which fails to comply with the requirements of the rule is an amendment after a non-final Office action, the LIE will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply (37 CFR 1.135). Extensions of time are permitted (37 CFR 1.136(a)). Failure to reply to this Notice

filed by "Express Mail" can only be accorded the date of receipt in the Office as the filing date (unless there is a postal interruption or emergency designated by the Office and applicants are instructed to file their applications in a manner other than by "Express Mail"). Any applicant who files an application by first class mail bears the risk of any delay in the delivery of the application to the Office, even if the delay is unusually significant due to some unforeseen event. New patent applications, computer readable format (CRF) biosequence listings, pre-grant publication submissions, and electronic information disclosure statements (e-IDS) may also be submitted to the USPTO via the Internet by using the Electronic Filing System (EFS). Information regarding EFS may be obtained via the USPTO web site at [www.uspto.gov/ebc/efs/index.html](http://www.uspto.gov/ebc/efs/index.html).<

## 512 Certificate of Mailing or Transmission [R-2]

### 37 CFR 1.8. Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on, the following:

(i) *Relative to Patents and Patent Applications—*

(A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d);

(B) The filing of correspondence in an interference which an examiner-in-chief orders to be filed by hand or "Express Mail";

(C) The filing of agreements between parties to an interference under 35 U.S.C. 135(c);

(D) The filing of an international application for patent;

(E) The filing of correspondence in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Preliminary Examining Authority;

(F) The filing of a copy of the international application and the basic national fee necessary to enter the national stage, as specified in § \*\* § 1.495(b).

(ii) \*\*>[Reserved]<

(iii) *Relative to Disciplinary Proceedings—*

(A) Correspondence filed in connection with a disciplinary proceeding under part 10 of this chapter.

(B) [Reserved]

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

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(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.<

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

A suggested format for a Certificate of Mailing and a Certificate of Transmission under 37 CFR 1.8 to be included with the correspondence is reproduced below.

### Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

\*\*>Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450<

on \_\_\_\_\_  
(Date)

Enclosure (2)

Typed or printed name of person signing this certificate

\_\_\_\_\_

Signature \_\_\_\_\_

#### Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. (703) \_\_\_\_\_)

on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate

\_\_\_\_\_

Signature \_\_\_\_\_

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#### ¶ 5.02 Format of Certificate of Mailing or Transmission

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

#### Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

on \_\_\_\_\_

(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

Signature: \_\_\_\_\_

#### Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office. Fax No. (703) \_\_\_\_\_ on \_\_\_\_\_ (Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

Signature: \_\_\_\_\_

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

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Under 37 CFR 1.8, a person may state on certain papers directed to the Office (exceptions are stated in 37 CFR 1.8), the date on which the paper will be deposited in the United States Postal Service or transmitted by facsimile. If the date stated is within the period for reply, the reply in most instances will be considered to be timely. This is true even if the paper does not actually reach the Office until after the end of the period for reply. The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.

The Certificate of Transmission procedure, however, also applies to papers transmitted to the Office from a foreign country provided that the correspondence being transmitted is not prohibited from being transmitted by facsimile and is not otherwise precluded from receiving the benefits under 37 CFR 1.8.

It should be noted, however, that the Office will continue its normal practice of stamping the date of receipt ("Office Date" Stamp) on all papers received through the mail or by facsimile except those filed under 37 CFR 1.10 (See MPEP § 513). The date stamped will also be the date which is entered on Office records and from which any subsequent periods are calculated. For example, 37 CFR 1.192 gives an appellant 2 months from the date of the appeal to file an appeal brief. For example, if the last day to reply to a final rejection was November 10, 1997, and applicant deposited a Notice of Appeal with fee in the U.S. mail on November 10, 1997, and so certified, that appeal is timely even if it was not received in the U.S. Patent and Trademark Office until November 16, 1997. Since the date of receipt will be used to calculate the time at which the brief is due, the brief was

due on January 16, 1998. This is 2 months after the Mail Center date.

37 CFR 1.8(a)(2)(i)(A) specifically refers to a request for a continued prosecution application (CPA) filed under 37 CFR 1.53(d) >(available only for design applications)< as a correspondence filed for the purposes of obtaining an application filing date and the procedures and benefit set forth in 37 CFR 1.8(a)(1) are not applicable to a request for a CPA. The date on a certificate of mailing or transmission (37 CFR 1.8(a)) of a CPA is not controlling or even relevant. A CPA filed by facsimile transmission will not be accorded a filing date as of the date on the certificate of transmission unless Office records indicate, or applicant otherwise establishes pursuant to 37 CFR 1.6(f), receipt in the Office of the complete CPA on the date on the certificate of transmission and that date is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

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## I. < PROCEDURE BY APPLICANT

(A) The certification requires a signature. Specifically, if the certification appears on a paper that requires a signature, two signatures are required, one for the paper and one for the certification. Although not specifically required by 37 CFR 1.8, it is preferred that the certificate be signed by the applicant, assignee, or registered practitioner.

(B) When possible, the certification should appear on a portion of the paper being submitted. However, if there is insufficient space to make the certification on the same paper, the certification should be on a separate sheet securely attached to the paper.

(C) When the certification is presented on a separate sheet, that sheet must (1) be signed and (2) fully identify and be securely attached to the paper it accompanies. The required identification should include the application number and filing date of the application as well as the type of paper being filed, e.g., reply to rejection or refusal, Notice of Appeal, etc. An unsigned certification will not be considered acceptable.

Moreover, without the proper identifying data, a certification presented on a separate sheet will not be considered acceptable if there is any question or doubt

concerning the connection between the sheet and the paper filed.

If the sheet should become detached from the paper and thereafter not associated with the appropriate file, evidence that this sheet was received in the Office can be supported by submitting a copy of a postcard receipt specifically identifying this sheet and the paper and by submitting a copy of the sheet as originally mailed. Attention is directed to MPEP § 503 relative to the use of postcards as receipts.

(D) In situations wherein the correspondence includes papers for more than one application (e.g., a single envelope containing separate papers responding to Office actions in different applications) or papers for various parts of the Office (e.g., a patent issue fee transmittal form PTOL-85B and an assignment), each paper must have its own certification as a part thereof or attached thereto.

Although \*\*>Part B of Form PTOL-85, Notice of Allowance and Fee(s) Due<, may contain a Certificate of Mailing thereon, a separate Certificate of Mailing is required for all papers included with this form, including formal drawings\*\*. Checks submitted with the papers do not require certification.

(E) In situations wherein the correspondence includes several papers directed to the same area of the Office for the same application (for example, a proposed reply under 37 CFR 1.116 and a Notice of Appeal), each paper should have its own certification as a part thereof or attached thereto.

(F) For the purposes of 37 CFR 1.8(a)(1)(i)(A), first class mail is interpreted as including "Express Mail" and "Priority Mail" deposited with the U.S. Postal Service.

Alternatively, the correspondence may be submitted with a cover or transmittal letter which itemizes the papers and on which is placed the certificate under 37 CFR 1.8.

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## II. < USE OF STAMPED CERTIFICATION

Some practitioners place the certification language on the first page of a paper with an inked stamp. Such a practice is encouraged because the certification is not only readily visible but also forms an integral part of the paper.

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### III. < OFFICE PROCEDURE

#### A. *Mail Center of the Office of Initial Patent Examination*

The Mail Center of the Office of Initial Patent Examination will continue to date stamp the actual date of receipt of all papers received by mail in the Office. No attempt will be made to retain the envelopes in which the papers are received or to indicate on the papers the postal cancellation date (postmark).

However, the benefits of 37 CFR 1.8 or 37 CFR 1.10 apply only to documents delivered to the Office by the U.S. Postal Service. A number of instances have been uncovered where individuals are certifying that documents were deposited with the U.S. Postal Service when, in fact, the documents were hand-carried or delivered to the Office via commercial couriers, e.g., "Federal Express," "DHL," "Purolator," "Air Borne," "UPS." In those instances where documents include a Certificate of Mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) but were delivered to the Office by other than the U.S. Postal Service, Mail Center personnel are placing a notice indicating that fact on the correspondence involved to alert Office personnel that the benefits of 37 CFR 1.8 or 37 CFR 1.10 do not apply.

#### B. *Processing Areas*

When papers are received in a \*\*>specific location of the Office (e.g., Pre-Grant Publication Division, Office of Patent Publication, Office of Petitions - see MPEP § 502 and § 502.01)<, the date of receipt in the \*>Office< is stamped on the papers in accordance with 37 CFR 1.6(a).

The date indicated on the Certificate of Mailing or of Transmission will be used by the Office only to determine if the paper was deposited in the United States Postal Service or transmitted by facsimile within the period for reply. If the paper was actually received in the Office within the period for reply, there is no need to refer to the Certificate. Note however, that 37 CFR 1.6(a)(3) provides that "[c]orrespondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the

Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia."

If, however, the paper was received in the U.S. Patent and Trademark Office after the end of the period for reply, the paper should be inspected to determine if a Certificate of Mailing or of Transmission has been included. Where no such Certificate is found, the paper is untimely since applicant did not reply within the period for reply. This may result in abandonment of the application or other loss of rights.

In those instances where a Certificate of Mailing or of Transmission does appear in the paper or a cover letter thereto, a check should be made to determine whether the indicated date of deposit or transmission is within the period for reply. If the date indicated in the Certificate is after the end of the period for reply, the paper is untimely and no notation of the date need be made. Where the date indicated on the Certificate is within the period for reply, the paper should be considered to be timely filed. A notation should be made adjacent to the Office stamp indicating the date of receipt ("Office Date" Stamp) which notes the date stated on the Certificate. This notation should be "C of Mail" or "C of Fax" followed by the date. A paper with a certificate dated November 10, 1997, would be noted next to the "Office Date" Stamp "(C of Mail. 11/10/97)." This notation should also appear on the "Contents" portion of the file wrapper. >For Image File Wrapper (IFW) processing, see IFW Manual.<

If the period set for taking an action in the U.S. Patent and Trademark Office ends on a Saturday, Sunday, or Federal holiday within the District of Columbia (37 CFR 1.7), the action will be considered to be timely if deposited in the United States mail or transmitted by facsimile and certified under 37 CFR 1.8(a) on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday.

It should be noted that the filing of a paper for the purpose of obtaining a continuation or division application under 37 CFR 1.53(d) >(available only for design applications)< and former 37 CFR 1.60 or 1.62 is excluded from the Certificate practice under 37 CFR 1.8(a)(2)(i)(A) since it is considered to be the filing of a national patent application.

Effective November 29, 1999, Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day if the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. See also 37 CFR 1.7(b). 35 U.S.C. 119(e)(3) as amended by Public Law 106-113 applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999.

No benefit will be given to a Certificate of Mailing or Transmission relative to the filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date. However, note that new patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as "Express Mail" with the United States Postal Service. For example, if a new patent application is deposited as "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).

All Certificates of Mailing or Transmission filed in applications should be placed in the file wrappers directly below the papers to which they refer. >For Image File Wrapper (IFW) processing, see IFW Manual.<

\*>Office< personnel receiving a hand-delivered paper from other than U.S. Postal Service personnel should inspect the paper to ensure that the benefits of 37 CFR 1.8 or "Express Mail" benefits under 37 CFR 1.10 are not accorded in error. If the paper contains a certificate of mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10), the words "HAND DELIVERED" should be written adjacent to the \* date stamp.

Applicant should be notified in the next Office action when a paper containing a Certificate of Mailing has been denied the benefits under 37 CFR 1.8 or a paper containing an "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) is denied benefits under 37 CFR 1.10 by including, for example, form paragraph 5.04.

#### ¶ 5.04 Benefit of Certificate of Mailing Denied

The [1] filed [2] is not entitled to the benefits of 37 CFR 1.10 since it was not deposited with the U. S. Postal Service for delivery to the U.S. Patent and Trademark Office. Therefore, the date of receipt in the U.S. Patent and Trademark Office has been used to determine the timeliness of the paper.

#### Examiner Note:

1. This form paragraph is to be used in those situations where correspondence contains a Certificate of Mailing under 37 CFR 1.8 or requests the benefit of "Express Mail" under 37 CFR 1.10, but the correspondence was not actually deposited with the U. S. Postal Service.
2. In bracket 3, insert --8-- or --10--, as appropriate.

Misuse of a Certificate of Mailing under 37 CFR 1.8 or improperly claiming the benefit of 37 CFR 1.10 which appears to be more than a one-time, inadvertent error should be brought to the attention of the Office of Enrollment and Discipline.

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#### IV. < ORIGINAL MAILED PAPER NOT DELIVERED

Paragraphs (b) and (c) of 37 CFR 1.8 concern the situation where a paper containing a Certificate was timely deposited in the U.S. mail or transmitted by facsimile, but never received by the U.S. Patent and Trademark Office. In the TCs, all submissions under these paragraphs should be considered and the sufficiency thereof determined by the TC Director. The statement required by 37 CFR 1.8(b)(3) is no longer required to be verified.

#### 513 Deposit as Express Mail with U.S. Postal Service [R-2]

##### 35 U.S.C. 21. Filing date and day for taking action.

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

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##### 37 CFR 1.6. Receipt of correspondence.

(a) Date of receipt and Express Mail date of deposit. Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for

correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) \*\*>[Reserved]<

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*37 CFR 1.10. Filing of correspondence by "Express Mail".*

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(a)(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

(2) The date of deposit with USPS is shown by the "date in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).<

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

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(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:<

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

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(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:<

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

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(3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:<

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

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(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned